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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,799	08/08/2001	Bernhard Boehmer	449122009900	9876
25227	7590	11/22/2004	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/923,799	<b>Applicant(s)</b> BOEHMER ET AL.	
	<b>Examiner</b> Joseph R. Pokrzywa	<b>Art Unit</b> 2622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/8/01</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The references listed in the Information Disclosure Statement submitted on 8/8/01 have been considered by the examiner (see attached PTO-1449).

### ***Drawings***

3. The drawings received on 8/8/01 are acceptable by the examiner.

### ***Specification***

4. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

***Claim Objections***

5. **Claim 6** is objected to because of the following informalities:

Regarding **claim 6**, in line 1, the examiner believes that “claim 1” should read “claim 5”, because of the reference of “the report”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1 and 8** are rejected under 35 U.S.C. 102(e) as being anticipated by Balma (U.S. Patent Number 6,157,945).

Regarding **claim 1**, Balma discloses a method for central coordination (network office appliance 100, seen in Figs. 1 and 2) of data transmission between a transmitting network element and a receiving network element (column 3, line 56-column 4, line 61), comprising requesting a converter service from a converter coordinator using the transmitting or receiving network element (column 4, lines 17-61), selecting the converter service using the converter coordinator and performing a data conversion on the data (column 4, lines 17-61, and column 6, line 42-column 7, line 8), wherein the transmitting and receiving network elements do not have compatible data or transmission formats (column 6, line 42-column 7, line 8).

Regarding **claim 8**, Balma discloses an apparatus for central coordination of data transmission (network office appliance 100, seen in Figs. 1 and 2) between a transmitting network element and a receiving network element (column 3, line 56-column 4, line 61), comprising at least one converter which is registered (column 4, line 37-column 5, line 20, and column 6, line 42-column 7, line 8), and at least one transmitting or receiving network element which receives a request for a converter service (column 4, line 37-column 5, line 20, and column 6, line 42-column 7, line 8), wherein the apparatus selects one of the at least one registered converters (column 4, lines 17-61, and column 6, line 42-column 7, line 8).

8. **Claims 1-10** are rejected under 35 U.S.C. 102(e) as being anticipated by Maruyama *et al.* (U.S. Patent Number 6,202,086).

Regarding **claim 1**, Maruyama discloses a method for central coordination of data transmission between a transmitting network element and a receiving network element (see Fig. 1, and column 3, lines 44-54), comprising requesting a converter service from a converter coordinator using the transmitting or receiving network element (column 3, lines 44-54, and column 8, lines 51-column 9, line 21), selecting the converter service using the converter coordinator and performing a data conversion on the data (column 3, lines 44-54, and column 10, line 40-column 11, line 63, seen in Fig. 10), wherein the transmitting and receiving network elements do not have compatible data or transmission formats (column 3, lines 40-61, and column 10, line 40-column 11, line 63).

Regarding **claim 2**, Maruyama discloses the method discussed above in claim 1, and further teaches that the transmitting and/or receiving network element is a terminal (see Fig. 1, and column 3, line 44-column 4, line 10).

Regarding **claim 3**, Maruyama discloses the method discussed above in claim 1, and further teaches that the transmitting and/or receiving network element is an application (column 4, lines 53-67, and column 10, line 41-column 11, line 63).

Regarding **claim 4**, Maruyama discloses the method discussed above in claim 1, and further teaches of sending a report via the converter service to the network element which produced the request (column 12, lines 8-20).

Regarding **claim 5**, Maruyama discloses the method discussed above in claim 1, and further teaches of sending a report via the converter service to the transmitting network element (column 12, lines 8-20), to the receiving network element (column 5, lines 37-55) and to the selected conversion service (column 12, lines 21-48).

Regarding **claim 6**, Maruyama discloses the method discussed above in claim 1, and further teaches that the report includes information about the interchange format to be used by the transmitting and receiving network elements (column 11, line 21-column 12, line 39).

Regarding **claim 7**, Maruyama discloses the method discussed above in claim 1, and further teaches that data is transmitted between the transmitting and receiving network elements via the converter without any further action by the converter coordinator (column 3, lines 44-61).

Regarding **claim 8**, Maruyama discloses an apparatus (apparatus 100) for central coordination of data transmission between a transmitting network element and a receiving network element (see Fig. 1, and column 3, lines 44-54), comprising at least one converter which

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is registered (column 3, lines 44-54, and column 10, line 40-column 11, line 63, seen in Fig. 10), and at least one transmitting or receiving network element which receives a request for a converter service (column 3, lines 44-54, and column 8, lines 51-column 9, line 21), wherein the apparatus selects one of the at least one registered converters (column 3, lines 40-61, and column 10, line 40-column 11, line 63).

Regarding **claim 9**, Maruyama discloses the apparatus discussed above in claim 8, and further teaches that the selected registered converter is sent as a response to the requesting network element (column 3, lines 44-54, and column 10, line 40-column 11, line 63, seen in Fig. 10).

Regarding **claim 10**, Maruyama discloses the apparatus discussed above in claim 8, and further teaches that the selected registered converter is sent as a response to relevant network elements (column 3, lines 44-54, and column 10, line 40-column 11, line 63, seen in Fig. 10).

#### ***Citation of Pertinent Prior Art***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Nicholls *et al.*** (U.S. Patent Number 6,363,414) discloses a system for converting messages into various formats; and

**Srinivasan** (U.S. Patent Number 6,072,862) discloses a system for delivering messages in numerous formats.

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***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa  
Examiner  
Art Unit 2622



jrj